

AKIMA-DTSV 07 APR 2005

PATENT

## UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. MBHB03-1070 (400/139))

IN THE APPLICATION OF:

McSwiggen, et al.

Serial No. 10/727,780

Filed: December 3, 2003

Title Inhibition Of Gene Expression Using  
Duplex Forming Oligonucleotides

)  
)  
) Examiner: To Be Assigned  
)  
) Group Art Unit: 1645  
)  
) Confirmation No.: 7111  
)  
) Fax No.: (703) 746-9195  
)

TRANSMITTAL LETTER

Mail Stop OIPE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Attn: Office of Initial Patent Examination's  
Filing Receipt Corrections

Dear Sir:

In regard to the above identified application,

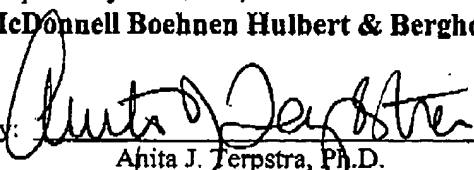
1. We are transmitting herewith the attached:
  - a) Request for Corrected Filing Receipt
  - b) Copy of Filing Receipt with changes noted thereon
  - c) Copy of Preliminary Amendment filed April 7, 2005
2. With respect to fees:
  - a) It is believed no fee is due at this time.
3. GENERAL AUTHORIZATION: Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.
4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1, are being transmitted via facsimile to the Mail Stop OIPE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 (Fax No. (703) 746-9195) on April 7, 2005.

Respectfully submitted,

McDonnell Boehnen Hulbert &amp; Berghoff LLP

Date: April 7, 2005

By:

  
Anita J. Terpstra, Ph.D.  
Registration No. 47,132

McDonnell Boehnen Hulbert & Berghoff LLP  
200 South Wacker Drive, Suite 2200  
Chicago, Illinois 60605

**PATENT****UNITED STATES PATENT AND TRADEMARK OFFICE**  
(Case No. MBHB03-1070 (400/139))

IN THE APPLICATION OF:	)		
	)		
McSwiggen, et al.	)	Examiner:	To Be Assigned
	)		
Serial No. 10/727,780	)	Group Art Unit:	1645
	)		
Filed: December 3, 2003	)	Confirmation No.:	7111
	)		
Title Inhibition Of Gene Expression	)	Fax No.:	(703) 746-9195
Using Duplex Forming	)		
Oligonucleotides	)		

**REQUEST FOR CORRECTED FILING RECEIPT**

Mail Stop OIPE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Office of Initial Patent Examination's  
Filing Receipts Corrections

1. Attached is a copy of a filing receipt received from the PTO in the above-referenced application for which issuance of a new corrected filing receipt is respectfully requested.
2. There is an error with respect to the following data, which is incorrectly entered.  
**Error in**  
Domestic Priority data as claimed by applicant

Foreign Applications:

UNITED STATES OF AMERICA PCT/US03/05346 02/20/2003

UNITED STATES OF AMERICA PCT/US03/05028 02/20/2003

USSN 10/727,780  
MBHB03-1070 (400/139)

**Correct Data**

Domestic Priority data as claimed by applicant:

This application is a CIP of 10/720,448 11/24/2003

which is a CIP of 10/693,059 10/23/2003

which is a CIP of 10/444,853 05/23/2003

which is a CIP of PCT/US03/05346 02/20/2003

and a CIP of PCT/US03/05028 02/20/2003

and said PCT/US03/05346 02/20/2003

claims benefit of 60/358,580 02/20/2002

and said PCT/US03/05028 02/20/2003

claims benefit of 60/358,580 02/20/2002

and said PCT/US03/05346 02/20/2003

claims benefit of 60/363,124 03/11/2002

and said PCT/US03/05028 02/20/2003

claims benefit of 60/363,124 03/11/2002

and said PCT/US03/05346 02/20/2003

claims benefit of 60/386,782 06/06/2002

and said PCT/US03/05028 02/20/2003

claims benefit of 60/386,782 06/06/2002

and said PCT/US03/05346 02/20/2003

claims benefit of 60/406,784 08/29/2002

and said PCT/US03/05028 02/20/2003

claims benefit of 60/406,784 08/29/2002

and said PCT/US03/05346 02/20/2003

claims benefit of 60/408,378 09/05/2002

and said PCT/US03/05028 02/20/2003

claims benefit of 60/408,378 09/05/2002

and said PCT/US03/05346 02/20/2003

claims benefit of 60/409,293 09/09/2002

and said PCT/US03/05028 02/20/2003

USSN 10/727,780  
MBHB03-1070 (400/139)

claims benefit of 60/409,293 09/09/2002  
and said PCT/US03/05346 02/20/2003  
claims benefit of 60/440,129 01/15/2003  
and said PCT/US03/05028 02/20/2003  
claims benefit of 60/440,129 01/15/2003

Foreign Applications:

~~UNITED STATES OF AMERICA PCT/US03/05346 02/20/2003~~

~~UNITED STATES OF AMERICA PCT/US03/05028 02/20/2003~~

3. In connection with this request, Applicant submits herewith a copy of the Preliminary Amendment filed in the instant application to correct the priority claim.
4. Applicant believes that no fee is due in connection with this filing; however, if a fee is due the Commissioner is authorized to charge our deposit account number 13-1249.

Respectfully submitted,  
McDonnell, Boehnen, Hulbert & Berghoff LLP

Date: April 7, 2005

By: 

Anita J. Terpstra, Ph.D.  
Registration No. 47,132



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/727,780	12/03/2003	1645	403	MBHB03-1070 (400/139)	13	22	1

CONFIRMATION NO. 7111

020306  
MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

## FILING RECEIPT

\*OC000000013418597\*

Date Mailed: 08/03/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

James McSwiggen, Boulder, CO;  
Narendra K. Vaish, Denver, CO;  
Shawn Zinnen, Denver, CO;

## Assignment For Published Patent Application

Sirna Therapeutics, Inc., Boulder, CO;

## Domestic Priority data as claimed by applicant

## Foreign Applications

~~UNITED STATES OF AMERICA PCT/US03/05346 02/20/2003~~  
~~UNITED STATES OF AMERICA PCT/US03/05028 02/20/2003~~

If Required, Foreign Filing License Granted: 08/02/2004

Projected Publication Date: To Be Determined - pending completion of Mis

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

This application is a CIP of 10/720,448 11/24/2003 which is a CIP of 10/693,059 10/23/2003 which is a CIP of 10/444,853 05/23/2003 which is a CIP of PCT/US03/05346 02/20/2003 and a CIP of PCT/US03/05028 02/20/2003 and said PCT/US03/05346 02/20/2003 claims benefit of 60/358,580 02/20/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/358,580 02/20/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/363,124 03/11/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/363,124 03/11/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/386,782 06/06/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/386,782 06/06/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/406,784 08/29/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/406,784 08/29/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/408,378 09/05/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/408,378 09/05/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/409,293 09/09/2002 and said PCT/US03/05028 02/20/2003 claims benefit of 60/409,293 09/09/2002 and said PCT/US03/05346 02/20/2003 claims benefit of 60/440,129 01/15/2003 and said PCT/US03/05028 02/20/2003

**Title**

Inhibition of gene expression using duplex forming oligonucleotides

**Preliminary Class**

435

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

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**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

## PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. MBHB03-1070 (400/139))

IN THE APPLICATION OF:

McSwiggen, et al.

Serial No. 10/727,780

Filed: December 3, 2003

Title Inhibition Of Gene Expression  
Using Duplex Forming  
Oligonucleotides

Examiner: To Be Assigned

Group Art Unit: 1645

Confirmation No.: 7111

TRANSMITTAL LETTERCommissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

- In regard to the above identified application,
1. We are transmitting herewith the attached:
    - a) Preliminary Amendment
    - b) Supplemental Application Data Sheet
  2. With respect to fees:
    - a) It is believed no fee is due at this time.
  3. GENERAL AUTHORIZATION: Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.
  4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 7, 2005.

Respectfully submitted,  
McDonnell Boehnen Hulbert & Berghoff LLP

Date: April 7, 2005

By:

  
Anita V. Terpstra, Ph.D.  
Registration No. 47,132McDonnell Boehnen Hulbert & Berghoff LLP  
100 South Wacker Drive, Suite 3200  
Chicago, Illinois 60606

## PATENT

## UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. MBHB03-1070 (400/139))

IN THE APPLICATION OF:

McSwiggen *et al.*

Serial No. 10/727,780

Filed: December 3, 2003

Title INHIBITION OF GENE EXPRESSION  
USING DUPLEX FORMING  
OLIGONUCLEOTIDES

Examiner: To Be Assigned

Group Art Unit: 1645

Confirmation No.: 7111

## PRELIMINARY AMENDMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the following preliminary amendment be entered in the above-mentioned application. It is believed that no fee is due in connection with this filing; however, if a fee is due the Commissioner is authorized to charge our deposit account number 13-1249.

Amendments to the Specification begin on page 2 of this paper.

Remarks/Arguments begin on page 3 of this paper.

McDonnell Boenhen Hulbert & Berghoff LLP  
300 South Wacker Drive, Suite 3200  
Chicago, IL 60606  
Tel: (312) 913-0001  
Fax: (312) 913-0002

Page 1 of 3



USSN 10/727,780

Attorney Docket No.: MBHB03-1070 (400/139)

**Amendments to the Specification:**

Please replace paragraph 1 with the following amended paragraph:

This application is a continuation-in-part of U.S. Patent Application No. ~~10/757,803, filed January 14, 2004, which is a continuation-in-part of U.S. Patent Application No. 10/720,448, filed November 24, 2003, which is a continuation-in-part of~~ U.S. Patent Application No. 10/693,059, filed October 23, 2003, which is a continuation-in-part of U.S. Patent Application No. 10/444,853, filed May 23, 2003, which is a continuation-in-part of International Patent Application No. PCT/US03/05346, filed February 20, 2003, and a continuation-in-part of International Patent Application No. PCT/US03/05028, filed February 20, 2003, both of which claim the benefit of U.S. Provisional Application No. 60/358,580 filed February 20, 2002, U.S. Provisional Application No. 60/363,124 filed March 11, 2002, U.S. Provisional Application No. 60/386,782 filed June 6, 2002, U.S. Provisional Application No. 60/406,784 filed August 29, 2002, U.S. Provisional Application No. 60/408,378 filed September 5, 2002, U.S. Provisional Application No. 60/409,293 filed September 9, 2002, and U.S. Provisional Application No. 60/440,129 filed January 15, 2003. The instant application claims the benefit of all the listed applications, which are hereby incorporated by reference herein in their entireties, including the drawings.

McDonnell Boehnen Hulbert & Berghoff LLP  
300 South Wacker Drive, Suite 3200  
Chicago, IL 60606  
Tel: (312) 913-0001  
Fax: (312) 913-0002

Page 2 of 3

USSN 10/727,780  
Attorney Docket No.: MBHB03-1070 (400/139)

**REMARKS/ARGUMENTS**

Applicant filed a Correction of Claim for Priority on March 30, 2004, to request that the claim for priority be added in the instant application (see Appendix A). However, Applicant erroneously included USSN 10/757,803 filed January 14, 2004 (i.e., filed after the instant application) in the priority claim. This amendment provides corrected priority information only and does not add new matter. Applicants respectfully request entry of the amendment.

Applicants submit herewith a Supplemental Application Data Sheet reflecting the deletion of USSN 10/757,803 from the priority claim.

Respectfully submitted,  
McDonnell Boehnen Hulbert & Berghoff LLP

Date: April 7, 2005

By: 

Anita J. Terpstra  
Registration No. 47,132

McDonnell Boehnen Hulbert & Berghoff LLP  
300 South Wacker Drive, Suite 3200  
Chicago, IL 60606  
Tel: (312) 913-0001  
Fax: (312) 913-0002

Page 3 of 3

**Supplemental Application Data Sheet****Application Information**

Application number:: 10/727,780  
Filing Date:: December 3, 2003  
Application Type:: Regular  
Subject Matter:: Utility  
Suggested Classification::  
Suggested Group Art Unit::  
CD-Rom or CR-R?:: None  
Number of CD disks:: None  
Number of copies of CDs:: None  
Sequence submission?::  
Computer Readable Form (CRF)?::  
Number of copies of CRF::  
  
Title:: INHIBITION OF GENE EXPRESSION USING  
DUPLEX FORMING OLIGONUCLEOTIDES  
  
Attorney Docket Number:: MBHB03-1070 (400/139)  
Request for Early Publication?:: No  
Request for Non-Publication?:: No  
Suggested Drawing Figure:: 13  
Total Drawing Sheets:: 13  
Small Entity?:: Yes  
Petition Included?:: No  
Petition Type::  
Licensed US Govt. Agency::  
Contract or Grant Numbers::  
Secrecy Order in Parent Appl.?::

**Applicant Information**

Applicant Authority type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: James  
Middle Name::  
Family Name:: McSwiggen  
Name Suffix::  
City of Residence:: Boulder  
State or Province of Residence:: Colorado  
Country of Residence:: United States of America  
Street of mailing address:: 4866 Franklin Drive  
City of mailing address:: Boulder  
State or Providence of mailing address:: Colorado  
Postal or Zip Code of mailing address:: 80301

Applicant Authority type:: Inventor  
Primary Citizenship Country:: India  
Status:: Full Capacity  
Given Name:: Narendra  
Middle Name:: K.  
Family Name:: Vaish  
Name Suffix::  
City of Residence:: Denver  
State or Province of Residence:: Colorado  
Country of Residence:: United States of America  
Street of mailing address:: 1313 Williams Street #503  
City of mailing address:: Denver  
State or Providence of mailing address:: Colorado  
Postal or Zip Code of mailing address:: 80218

Applicant Authority type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Shawn  
Middle Name::  
Family Name:: Zinnen  
Name Suffix::  
City of Residence:: Denver  
State or Province of Residence:: Colorado  
Country of Residence:: United States of America  
Street of mailing address:: 2378 Birch Street  
City of mailing address:: Denver  
State or Providence of mailing address:: Colorado  
Postal or Zip Code of mailing address:: 80207

**Correspondence Information**

Correspondence Customer Number:: 020306  
Phone Number:: (312) 913-0001  
Fax Number:: (312) 913-0002  
E-Mail Address:: docketing@mbhb.com

**Representative Information**

Representative Customer Number::	020306
----------------------------------	--------

**Domestic Priority Information**

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This application	Continuation in part of	40/757,803	01/14/2004

<u>This application</u> <u>10/757,803</u>	Continuation-in-part of	10/720,448	11/24/2003
10/720,448	Continuation-in-part of	10/693,059	10/23/2003
10/693,059	Continuation-in-part of	10/444,853	05/23/2003
10/444,853	Continuation-in-part of	PCT/US03/05346	02/20/2003
10/444,853	Continuation-in-part of	PCT/US03/05028	02/20/2003
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/358,580	02/20/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/363,124	03/11/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/386,782	06/06/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/406,784	08/29/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/408,378	09/05/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/409,293	09/09/2002
PCT/US03/05346 And PCT/US03/05028	An application claiming the benefit under 35 USC 119(e)	60/440,129	01/15/2003

### Foreign Priority Information

Country::	Application Number::	Filing Date::	Priority Claimed::
WO (World Intellectual Property Organization)	PCT/US03/05346	02/20/2003	Yes
WO (World Intellectual Property Organization)	PCT/US03/05028	02/20/2003	Yes

**Assignee Information**

Assignee Name:: Sirna Therapeutics, Inc.  
Street of mailing address:: 2950 Wilderness Place  
City of mailing address:: Boulder  
State or Province of mailing address:: Colorado  
Country of mailing address:: United States of America  
Postal or Zip Code of mailing address:: 80301

Hon. Commissioner of  
Patents and Trademarks

S/N 10/727,780

Atty AJT/co

Re: Applicant - McSwiggen et al.

Case No. MBHB03-1070 (400/139)

INHIBITION OF GENE EXPRESSION USING DUPLEX FORMING OLIGONUCLEOTIDES

Sir:

Please place the Patent Office receipt stamp hereon and mail to acknowledge receipt of:

- ☒ Transmittal Letter (in duplicate)
- ☒ Preliminary Amendment
- ☒ Supplemental Application Data Sheet
- ☒ Other: None

Fee Enclosed

\$ 0.00  
April 7, 2005

Respectfully,  
McDonnell Bochenen Hulbert & Berghoff LLP  
Attorney for Applicant



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